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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,341	10/19/2000	Giles Roger Frazier	AUS9-2000-0633-US1	7015
35525	7590	03/15/2005	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			THOMPSON, MARC D	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,341

Applicant(s)

FRAZIER ET AL.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040623, 20040416, 20040419

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This application has been reassigned to a new Examiner. See Conclusion section below, for new Examiner contact information.
2. The amendment, received 4/19/2004, has been entered into record.
3. Claims 1-7, 9-16, and 18-20 remain pending.

Priority

4. No claim for priority has been made in this application.
5. The effective filing date for the subject matter defined in the pending claims in this application is 10/19/2000.

Specification

6. The disclosure is objected to because of the following informalities:
 1. The specification cites multiple pending and non-pending patent application which range from patented documents to abandoned applications. The citation of each and every document cited at Page 1 of the specification must reflect the current status of that specific cited document. The revision submitted on 4/19/2004 fails to provide resulting patent numbers or currently abandoned status for each of the cited documents for which these labels are appropriate.
 2. This amendment to the specification, present in the Response, has improperly cited at least one serial number of "related" applications, namely, 09/692,334, in Line 7 of the marked up version of the amended paragraph. Applicant is required to verify all the information

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submitted in this amendment for accuracy.

Appropriate correction is required.

Drawings

7. The Examiner contends that the drawings submitted on 10/19/2000 are acceptable for examination proceedings.

Information Disclosure Statements

8. It should be noted that Applicant has submitted an exorbitant amount of prior art on numerous PTO-1449's which on initial consideration appears to not all have relevancy or pertinence to the instant invention as claimed. Further, no indication of why this art was cited, or for what reasons are provided. Due to the high volume of submitted art and serious time constraints, the Examiner is unable to review each document at the same level of detail as would be available for prior art sets of smaller size. Applicant is requested in response to this Office action to point out which of these numerous prior art are pertinent or relevant to the patentability of the invention as claimed in this instant application. It should be noted that it would be advantageous to the Applicant to provide a concise explanation of why each of the prior art is being submitted and how it is understood to be relevant. "Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability." (See MPEP 609 under subheading "A. CONTENT").

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 18 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, the claimed invention lacks patentable utility, and the disclosed invention is inoperative and therefore lacks utility.

11. Claims 18 and 19 recite “a computer program product in a computer readable medium for use for initializing a subnet manager in a network computing system, the computer program product comprising...” in the preamble of the claims. The claims fail to specify the requirement for a computer, and the intrinsic execution/interpretation of the computer program to effect physical condition(s) of real things. Also see MPEP § 2106 regarding computer related inventions. Note that “software” is generally not patentable as such, but must be claimed as process steps, or as machine, or as manufacture. For example, software may be claimed as machine or [article of] manufacture by stating “a computer readable media containing instructions, which when executed, cause the following steps to be performed...”

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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13. Claims 1-7, 9-16, and 18-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. All of the claims recite "...if an excessive amount of polling packets are received..." as amended into the claims in the last Response, received 4/19/2004. The amount of polling packets which constitutes an excessive amount is indefinite. There is no ascertainable metes and bounds for this limitation, since minimally, an identical range or amount of polling packets per unit time may or may not be deemed "excessive", based for example, on the processing power of the receiver.

15. Claims 1-7, 9-16, and 18-20 are rejected.

Allowable subject matter

16. The prior art of record fails to disclose, teach or suggest, alone or in combination, a plurality of subnet managers that each implement a state machine and that placing subnet managers in a dormant state includes either receiving user input designating that state machines of the subnet managers are to be transitioned to a disabled state or automatically transitioning the state machines of the subnet managers to a non-active standby state if an excessive amount of polling packets are received by a master subnet manager, as presently claimed, interpreted in view of portions of the enabling specification, inter alia, at Pages 21 and 24-29.

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Conclusion

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The Examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, William Cuchlinski, Jr. can be reached at 571-272-3925. The fax phone number for the organization where this application or proceeding is assigned remains 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON
MARC THOMPSON
PRIMARY EXAMINER

Marc D. Thompson
Primary Examiner
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